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JUN 23 2008

OFFICE OF PETITIONS

In re Application of
Mitchell, et al.
Application No. 10/614,940
Filed: 7 July, 2003
Attorney Docket No. 590-004

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: DECISION
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This is a decision on the petition, filed on 15 March, 2007, and supplemented on 6 June, 2008, considered as a petition under 37 C.F.R. §1.181 (no fee) requesting withdrawal of the holding of abandonment in the above-identified application, alternatively for relief under the provisions of 37 C.F.R. §1.182 and §1.183; finally, alternatively for relief as revival of an application abandoned due to unavoidable delay or (as previously pleaded) unintentional delay, respectively, under 37 C.F.R. §1.137(a) or §1.137(b).

The Office regrets the delay in addressing this matter, however, the instant petition was presented to the attorneys in the Office of Petitions only at this writing.

The petition under:

- 37 C.F.R. §1.181 is **DISMISSED**;
- 37 C.F.R. §1.182 is **DISMISSED**;
- 37 C.F.R. §1.183 is **DISMISSED**;
- 37 C.F.R. §1.137(a) is **DISMISSED**;
- 37 C.F.R. §1.137(b) is **GRANTED**.

As to the Request to Withdraw
the Holding of Abandonment

A proper showing (for relief under 37 C.F.R. §1.181):

- (as to non-receipt) requires at the very minimum: a statement from practitioner stating that the Office action was not received by the practitioner; a statement from the practitioner attesting to the fact that a search of the file jacket and docket records for the application indicates that the Office action was not received with a copy of those docket records; and a brief statement of the calendaring process and a copy of the due-date (calendar) docket record(s) where the nonreceived Office action would have been scheduled for reply had it been received must be attached to and referenced in the practitioner's statement; alternatively,
- (for a showing of timely and proper reply) a statement from practitioner stating that the reply was timely submitted by the practitioner; and copies of all papers submitted as and/or in support of that reply, with/and a copy of the date-stamped receipt card, Office FAX receipt acknowledgement (not simply Petitioner's FAX transmittal), or EFS receipt acknowledgment from the Office, along with practitioner's attestation as to the correctness/completeness of his/her records.

The showing(s) must include that of the person(s) with first-hand knowledge and an acknowledgment by the Petitioner that he/she has reviewed that information in compliance with his/her duty of candor to the Office.

As to Relief
under 37 C.F.R. §1.182

A proper showing that relief is not alternatively set forth under another regulatory provision.

As to Relief
under 37 C.F.R. §1.183

A proper showing that the interests of justice require a waive of the rules.

As to Allegations of
Unavoidable Delay

The requirements of a grantable petition pursuant to 37 C.F.R. §1.137(a) are the petition and fee therefor, a reply, a proper showing of unavoidable delay under the regulation, and, where applicable, a terminal disclaimer and fee. (However, it does not appear that a terminal disclaimer and fee are due here.)

As to Allegations of
Unintentional Delay

The requirements of a grantable petition pursuant to 37 C.F.R. §1.137(b) are the petition and fee therefor, a reply, a proper statement of unintentional delay under the regulation, and, where applicable, a terminal disclaimer and fee. (However, it does not appear that a terminal disclaimer and fee are due here.)

BACKGROUND

The record reflects as follows:

After a change of Power of Attorney in March 2005, from Kristofer Halvorson (Reg. No. 39,211) (Mr. Halvorson) to David A. Gass (Reg. No. 38,153) (Mr. Gass), the Assignee—Phlo System Inc. (PSI) by and through James B. Hovis (Mr. Hovis), representing to the Office that he was President of said Assignee—representing to the Office that it held 100 percent of the interest in the instant application (and upon presenting to the Office a copy of the Assignment) sought on 26 January, 2006, an Express Abandonment, which was granted on 6 February, 2006.

The application remained abandoned thereafter.

On 24 April, 2006, Petitioner Mr. Halvorson filed the original petition representing a lack of authority by PSI and/or Mr. Hovis to seek and obtain an express abandonment, and alleging therein other matters not of record. There was, at the very least an incongruity in the representations made by Petitioner considered in contrast to the record as it previously stood, and for that reason the original petitions under 37 C.F.R. §1.181, alternatively §1.182 and §1.183, or for revival of an application abandoned due to unintentional delay, respectively under 37 C.F.R. §1.137(a) or §1.137(b) were dismissed on 7 June, 2006.

The instant petitions were filed on 15 March, 2007, and supported with a judgment of the Court of Chancery of the State of Delaware in and for New Castle County, which appears to have been entered on 30 January, 2007, and a signed and certified copy of said order was presented to the Office on 2 June, 2008—said Order declaring the “Alliance Agreement,” and thus the assignment to PSI void *ab initio*, and all rights to, *inter alia*, the instant application returned to Petitioners herein ““as if it never left.”¹

In view of the Final Judgment and Order of 30 January, 2007, of the Court of Chancery of the State of Delaware in and for New Castle County, the showing of unintentional delay under 37 C.F.R. §1.137(b) has been satisfied, and the other regulatory requirements of petition, fee, such reply as was necessary (and there was none), appear to be satisfied and/or otherwise complete.

¹ Final Judgment and Order of 30 January, 2007, at page 2.

Out of an abundance of caution, Petitioners always are reminded that the filing of a petition under 37 C.F.R. §1.181 does not toll any periods that may be running any action by the Office and a petition seeking relief under the regulation must be filed within two (2) months of the act complained of (see: 37 C.F.R. §1.181(f)), and that those registered to practice and all others who make representations before the Office are reminded to inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation—since all owe to the Office the continuing duty to disclose.²

The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner on-demand information as to events/transactions in an application.

(*See* MPEP § 711.03(c) under subheading "Petition to Withdraw Holding of Abandonment Based on Failure to Receive Office Action," alternative "A Reply Was Timely Filed"; *see also*: "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 *Official Gazette* 53 (November 16, 1993).)

Allegations as to the Request to
Withdraw the Holding of Abandonment

The courts have determined the construct for properly supporting a petition seeking withdrawal of a holding of abandonment.³ (*See*, also, the commentary at MPEP §711.03(c)(I)(A) and (B).) And the regulation requires that relief be sought within two (2) months of the act complained of.

Petitioner failed make the showing required.

As to Relief
under 37 C.F.R. §1.182

The showing that relief is not alternatively set forth under another regulatory provision is incomplete at this writing.

As to Relief
under 37 C.F.R. §1.183

The showing that the interests of justice require a waive of the rules is incomplete at this writing.

² *See* supplement of 17 June, 1999. The Patent and Trademark Office is relying on Petitioner's duty of candor and good faith and accepting a statement made by Petitioner. *See Changes to Patent Practice and Procedure*, 62 *Fed. Reg.* at 53160 and 53178, 1203 *Off. Gaz. Pat. Office* at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).

³ *See: Delgar v. Schulyer*, 172 USPQ 513 (D.D.C. 1971).

As to Allegations of
Unavoidable Delay

The requirements under 37 C.F.R. §1.137(a) of a showing of unavoidable delay is incomplete as of this writing.

As to Allegations of
Unintentional Delay

The requirements under 37 C.F.R. §1.137(b) have been satisfied.

CONCLUSION

Accordingly, The petition under:

- 37 C.F.R. §1.181 is **dismissed**;
- 37 C.F.R. §1.182 is **dismissed**;
- 37 C.F.R. §1.183 is **dismissed**;
- 37 C.F.R. §1.137(a) is **dismissed**;
- 37 C.F.R. §1.137(b) is **granted**.

The instant application is released to Technology Center/AU 1618 for further processing in due course.

Petitioner may find it beneficial to view Private PAIR within a fortnight of the instant decision to ensure that the revival has been acknowledged by the Technology Center/AU in response to this decision. It is noted that all inquiries with regard to that change in status need be directed to the Technology Center/AU where that change of status must be effected—that does not occur in the Office of Petitions.

While telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214, it is noted that all practice before the Office is in writing (see: 37 C.F.R. §1.2⁴) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).



/John J. Gillon, Jr./
John J. Gillon, Jr.
Senior Attorney
Office of Petitions

⁴ The regulations at 37 C.F.R. §1.2 provide:

§1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.



03-16-07

Handwritten signature/initials

PETITION TO REVIVE ABANDONED APPLICATION FOR PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Mitchell et al. Group Art Unit:1645
Serial No.: 10/614,940
Filed: July 7, 2003
For: Oral Rehydration Compositions Containing Liposomes

Commissioner of Patents and Trademarks
Mail Stop Petition
PO Box 1450
Alexandria, VA 22313-1450

PETITION TO REVIVE ABANDONED APPLICATION UNDER THE PROVISIONS OF 37 C.F.R. 1.181,
37 C.F.R. 1.182, 37 C.F.R. 1.183, AND 37 C.F.R. 1.137(A)

Refund Ref: 06/24/2008 CKHLOK 0000163315
CHECK Refund Total: \$400.00

Dear Sir:

Petitioner Cheryl R. Mitchell and James B. Mitchell by and through their attorney respectfully petition the Commissioner of Patents and Trademarks to revive the above-identified application.

For the reasons stated below, Petitioner asks that the Commissioner to exercise authority pursuant to 37 C.F.R. §§1.181, 1.182, and 1.183 to revive the application.

Alternatively, Petitioner requests revival of the application under 37 C.F.R. §1.137(a).

Documents and Fees Filed in Support of this Petition

In support of this petition to revive, Petitioner incorporates by reference all the documents in the application prosecution history and files herewith the following documents and fees:

- Memorandum Opinion, Court of Chancery of the State of Delaware in and for New Castle County, *Creative Research Manufacturing v. Advanced Bio-Delivery LLC and Phlo systems, Inc.*, Civil Action No. 1211-N, Decided January 30, 2007.

0702.001.080

Adjustment date: 06/24/2008 CKHLOK 0000163315
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the parties in this case. *See* Final Order and Judgment, paragraph 4.


The lapse of prosecution by Petitioner was unavoidable because Petitioner could not control prosecution of the application until the litigation was concluded. Petitioner acted as a reasonably prudent person in the prosecution of the application while it was within Petitioner's power to control the prosecution. Petitioner diligently sought to protect Petitioner's property by filing suit to recover Petitioner's property. Petitioner further showed diligence by filing the prior petition to revive upon discovery of the express abandonment. As the Memorandum Opinion shows, the Petitioner was diligent even in the litigation. Any delay by Petitioner in this matter was completely unavoidable because Petitioner had to wait for the resolution of ownership by the court.

Petitioner requests that the Commissioner:

- Adopt the ruling of the Court of Chancery of Delaware that (1) the assignment is of no force or effect and (2) the express abandonment is invalid *ab initio*;
- Accept the appointment of Kristofer E. Halvorson as the attorney of record;
- Find that Petitioner was diligent in prosecuting the application;
- Find that the delay by Petitioner in prosecuting the application was unavoidable;
- Revive the petition as requested in the PTO Form SB/61 filed herewith.

The Petitioner files herewith in support of this request under §1.137(a) the fee set forth in 1.17(l).

Date: 3/15/07


Respectfully submitted,

Kristofer E. Halvorson
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1757 E. Baseline Rd., Ste 130
Gilbert, Arizona 85233
(480) 892-2037

UNITED STATES PATENT & TRADEMARK OFFICE
Washington, D.C. 20231

REQUEST FOR PATENT FEE REFUND										
1 Date of Request: _____		2 Serial/Patent # <u>10/614948</u>								
3 Please refund the following fee(s):		4 PAPER NUMBER	5 DATE FILED	6 AMOUNT						
	Filing			\$						
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	Notice of Appeal/Appeal			\$						
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	Issue			\$						
	Cert of Correction/Terminal Disc.			\$						
	Maintenance			\$						
	Assignment			\$						
	Other			\$						
			7 TOTAL AMOUNT OF REFUND	\$ <u>400.00</u>						
8 TO BE REFUNDED BY:										
10 REASON:		<input checked="" type="checkbox"/> Treasury Check								
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